

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>AIS-P99-1</b>			
<div>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>2012-08-28</u> via EFS</div> <div>Signature <u>/PeterKTrzyna/</u></div> <div>Typed or printed name <u>Peter K. Trzyna, Esq.</u></div>	Application Number <b>09/399,578</b>	Filed <b>1999-09-20</b>			
	First Named Inventor <b>MARKS, Daniel L.</b>				
	Art Unit <b>2452</b>	Examiner <b>WINDER, Patrice L.</b>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><div><input type="checkbox"/> applicant/inventor.</div><div><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div><div><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>32,601</u></div><div><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</div></td><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><div><u>/PeterKTrzyna/</u> Signature</div><div><u>Peter K. Trzyna, Esq.</u> Typed or printed name</div><div><u>(312) 240-0824</u> Telephone number</div><div><u>2012-08-28</u> Date</div></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<div><input type="checkbox"/> applicant/inventor.</div> <div><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div> <div><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>32,601</u></div> <div><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</div>	<div><u>/PeterKTrzyna/</u> Signature</div> <div><u>Peter K. Trzyna, Esq.</u> Typed or printed name</div> <div><u>(312) 240-0824</u> Telephone number</div> <div><u>2012-08-28</u> Date</div>
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<div><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</div>					

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

## **1. Improper provisional double patenting rejection**

In the final rejection, a provisional double patenting rejection was issued based on only one claim element. See pages 3-4. This rejection is an improper rejection because (A) all the claim limitations must be considered, (B) a mapping or matrix of the limitations is to be provided for the five patent applications and hundreds of claims at issue, i.e., for the pending hundreds of claims vis-à-vis claims 1-58 of Ser. No. 11/510,463, plus claims 1-63 of Ser. No. 11/510,351, plus claims 1-84 of Ser. No. 11/510,473, plus claims 1-37 of Ser. No. 11/836,633. As to (A) see MPEP Secs 804, 2142-2143 "All Claim Limitations Must Be Considered." As to (B) see MPEP Sec. 706 and 37 CFR 1.104: "The pertinence of each reference, if not apparent, must be clearly explained). See too MPEP Secs. 2142-43, 2184.

Further, the Examiner has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in 35 U.S.C. Sec. 132. Absent a proper Sec. 103 analysis and the mapping or matrix of the claim limitations, and the information required by Sec. 132, as well as compliance with the above-cited portions of the MPEP and decisions cited therein, this is an improper provisional double patenting rejection.

## **2. Improper rejection of all claims pursuant to 35 U.S.C. Sec. 103: Failure to give proper care / consideration to a Declaration; evidence of unobviousness**

The Declaration of Professor Lee Hollaar, at paragraphs 14-17, provides evidence of unobviousness. However, there is no showing in the Advisory Action that these paragraphs received any consideration whatsoever. See the Advisory Action.

The Examiner ignored Applicant's filed evidence stating, in the Advisory Action "the examiner is confused because the remarks refer to an affidavit of Dr. Chandrajit Baja. However, the affidavit is provided by Professor Lee Hollaar." Applicant grants that Applicant made a typographical error in the Remarks in the filing of April 2012, but not in the Transmittal Letter, and more so, a typographical error does not excuse ignoring Applicant's submitted

evidence of unobviousness. See the Advisory Action. This is improper pursuant to MPEP Sec. 716.01(a) and cases cited therein.

See MPEP Sec. 716.01(a) requires that "declarations... containing evidence of...skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103." Also, MPEP Sec. 2142 (and 2134, 2184), which states:

"When an applicant submits evidence...the examiner must reconsider the patentability of the claimed invention. The decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and the evidence submitted by the applicant. A decision to make or maintain a **rejection** in the face of all the evidence **must show that it was based on the totality of the evidence...**" ( Bolding added.)

The failure to show consideration being given to this evidence of unobviousness is an improper rejection of the claims pursuant to Sec. 103 pursuant to the above-quoted portions of the MPEP and cases cited therein.

### **3. Improper rejection of all claims pursuant to 35 U.S.C. Sec. 132**

Further, the Examiner has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in 35 U.S.C. Sec. 132. Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". Applicant has been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth because the rejection shows no response to the evidence of unobviousness. Applicant also has been denied this entitlement because the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*".

Otherwise, the rejection is improper. The Examiner has failed to meet this obligation under 35 U.S.C. Sec. 132, especially regarding the evidence of non-obviousness set out in the Declaration of Professor Hollaar and the full and proper Interview of Dr. Chandrajit Baja.